



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/994,929

11/28/2001

Shinji Yoshida

040894-5745

7277

9629

7590

10/30/2006

MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

EXAMINER

CHEN, SHIN HON

ART UNIT

PAPER NUMBER

2131

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/994,929

Applicant(s)

YOSHIDA, SHINJI

Examiner

Shin-Hon Chen

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-8 and 13-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-8 and 13-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-2, 5-8, and 13-23 have been examined.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/27/06 has been entered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over “5C Digital Transmission Content Protection White Paper” (hereinafter DTCP) in view of Ueki U.S. Pat. No. 6678236 (hereinafter Ueki).

5. As per claim 1 and 2, DTCP discloses a data reproducing device for reproducing data recorded in a data storing disk, said data reproducing device comprising: a copy protection unit adapted, when an encrypted data over the data storage region of said data storing disk is copied

Art Unit: 2131

in response to a demand of an external device, to perform an authentication with reference to the copy protection information read by said pickup unit thereby to output the information, as contained in the copy protection information and relating to a secret key, to the external device which is recognized to be correct through the authentication (DTCP: page 1: the 1394 content protection architecture and the DTCP architecture). DTCP does not explicitly disclose a pickup unit for reading a copy protection information which is written in advance as a surface shape such as slits or corrugations in a region over a substrate of said data storing disk other than a data storage region. However, Ueki discloses the Content Scrambling System method of content protection which keys required to decrypt the encrypted data are stored on the lead-in area of the disc, which can only read by compliant devices and a secret information is written in advance as the surface shape such as slits or corrugations in the region over a substrate other than a data storage region (Ueki: column 1 lines 20-63; column 8 line 62 – column 9 line 5; and abstract: the copyright protection information and CSS key information are stored in the pre-pits area of the lead-in area). It would have been obvious to one having ordinary skill in the art to store the secret information into the lead-in area of a disk so that only compliant devices that have the license can reproduce the protected data because different content protection architectures proposed by “5C” group can be combined to achieve greater copy protection. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant’s invention to combine the teachings of Ueki within DTCP because lead-in area of the disk is difficult to access.

6. As per claim 23, DTCP as modified discloses the hard disk of claim 2. DTCP as modified further discloses general-purpose application software matching the external device can be

Art Unit: 2131

recorded in advance in the pre-recording region of the disk (Ueki: column 1 lines 20-63; column 8 line 62 – column 9 line 5; and abstract: the copyright protection information and CSS key information are stored in the pre-pits area of the lead-in area).

7. Claim 5-8 and 13-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ueki.

8. As per claim 5 and 6, Ueki discloses a data reproducing device for reproducing data recorded in a data storing disk, comprising: a digital recording/reproducing device for reading a program which is optically recorded in advance in the region over a substrate of a data storing disk other than a data storage region (Ueki: column 1 lines 20-63; column 8 line 62 – column 9 line 5; and abstract: the copyright protection information and CSS key information are stored in the pre-pits area of the lead-in area); and a reproduce control unit for reproducing the program recorded in the region, through the optical head at the time of reproducing the data from the region over the substrate of said data storing disk other than the data storage region, and for recording a program or data in the region through said optical head at a data recording time, a secret information is written in advance as the surface shape such as slits or corrugations in the region over a substrate other than a data storage region (Ueki: column 1 lines 20-63; column 8 line 62 – column 9 line 5; and abstract: the copyright protection information and CSS key information are stored in the pre-pits area of the lead-in area). Ueki discloses the Content Scrambling System method of content protection which keys required to decrypt the encrypted data are stored on the lead-in area of the disc, which can only read by compliant devices and the

Art Unit: 2131

recording/reproducing device will retrieve the CSS key/ content protection information to decrypt the encrypted data. Ueki discloses the content protection method for DVD. However, it would have been obvious to one having ordinary skill in the art to apply the content protection architecture on analog data because digital and analog are interchangeable in modern days and the Digital Transmission Content Protection architecture has been applied to analog device. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to apply the CSS architecture to analog media.

9. As per claim 7 and 8, claims 7 and 8 encompass the same scope as claims 5 and 6. Therefore, claims 7 and 8 are rejected based on the same reasons set forth in claims 5 and 6.

10. As per claim 13 and 14, Ueki as modified discloses the disk according to claims 5 and 7. Ueki as modified further disclose wherein a program is recorded in a region over a substrate other than a data storage region (Ueki: column 1 lines 20-63; column 8 line 62 – column 9 line 5; and abstract: the copyright protection information and CSS key information are stored in the pre-pits area of the lead-in area). Ueki does not explicitly disclose magnetically recording. However, it would have been obvious to one having ordinary skill in the art to apply the content protection architecture on analog data because digital and analog are interchangeable in modern days and the Digital Transmission Content Protection architecture has been applied to analog device. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to apply the CSS architecture to analog media.

Art Unit: 2131

11. As per claim 15-18, Ueki as modified discloses the disk according to any of the claims 1, 2, 5, 6-8, and 14. Ueki as modified further discloses the secret information is a copy protection information (Ueki: column 1 lines 20-63; column 8 line 62 – column 9 line 5; and abstract: the copyright protection information and CSS key information are stored in the pre-pits area of the lead-in area).

12. As per claim 19-22, Ueki as modified discloses the disk according to any of claims 1, 2, 5, 7, 8, 13 and 14. Ueki as modified further discloses wherein a program or data is capable of being recorded/reproduced in/from the region over said substrate other than the data storage location (Ueki: column 1 lines 20-63; column 8 line 62 – column 9 line 5; and abstract: the copyright protection information and CSS key information are stored in the pre-pits area of the lead-in area). Ueki does not explicitly disclose magnetically recording. However, it would have been obvious to one having ordinary skill in the art to apply the content protection architecture on analog data because digital and analog are interchangeable in modern days and the Digital Transmission Content Protection architecture has been applied to analog device. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to apply the CSS architecture to analog media.

Response to Arguments

13. Applicant's arguments filed on 9/27/06 have been fully considered but they are not persuasive.

Regarding applicant's remarks, applicant argues the references do not disclose recording copy protection information in advance as a surface shape such as slits or corrugations in a region over substrate of said data storing disk other than a data storage system. However, Ueki explicitly discloses storing copy protection information in lead-in areas which include pre-pit area with certain depth (Ueki: figure 7 and 9). Therefore, applicant's argument is respectfully traversed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shin-Hon Chen whose telephone number is (571) 272-3789. The examiner can normally be reached on Monday through Friday 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shin-Hon Chen
Examiner
Art Unit 2131

Application/Control Number: 09/994,929
Art Unit: 2131

Page 8

SC

CHRISTOPHER REVAH
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'CR', is located below the printed name and title.